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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/696,231 | 10/29/2003 | Merlin Stover | P06457US00 | 5252 |
| 22885 | 7590 | 03/12/2004 | EXAMINER | |
| MCKEE, VOORHEES & SEASE, P.L.C. 801 GRAND AVENUE SUITE 3200 DES MOINES, IA 50309-2721 | | | KOYAMA, KUMIKO C | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2876 | |

DATE MAILED: 03/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|----------------------|--------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/696,231 | STOVER, MERLIN | |
| | Examiner | Art Unit | |
| | Kumiko C. Koyama | 2876 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Drawings

1. New corrected drawings are required in this application because it includes hand written reference numbers. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Specification

2. The abstract of the disclosure is objected to because it includes improper language such as "provided." The examiner respectfully suggests the Applicant the following changes:

Line 1: "provided" should be changed to --included--.

Line 6: "provided" should be changed to --given--.

Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re claim 1, line 2: The claim recites "...a negotiable instrument from a writer having a pre-printed bar code..." The claim language is unclear as to whether the negotiable instrument has the pre-printed bar code or the writer has the pre-printed bar code. The examiner respectfully requests the Applicant to rewrite the claim in order to clarify who has the pre-printed bar code. For examination purposes, the examiner has interpreted that the negotiable instrument has the pre-printed bar code as well as the photo identification and the pre-printed signature.

5. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 recites "where in the personal information is...signature." However, claim 7 is dependent on claim 6, where the claim recites "a check without any personal information visible," but yet also recites "a signature of the writer pre-printed upon the negotiable instrument for comparison by the writer." The examiner is unclear as to how the personal information/signature can be invisible upon the check, but yet having a signature comparable by the writer. The examiner is also unclear whether the personal information (signature) is related to the signature that is compared by the writer. The examiner respectfully requests the Applicant to clarify this matter. For examination purposes, the examiner has interpreted the personal information as the social security number as recited in claim 7.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Armel (US 5,442,162) in view of Martin (US 6,390,362, as cited by the Applicant).

Armel teaches a traveler's check, which is a negotiable instrument, including a portrait 20 and a signature 22 (Fig. 1). The party receiving the traveler's check 10 may readily compare the portrait 20 and signature facsimile 22 of the individual customer to whom the check was issued with the appearance and signature of the transferor in deciding whether or not to accept the check (col 4, lines 4-10).

Armel fails to teach reading bar code on the negotiable instrument and deriving personal identification information from the bar code and comparing the personal identification information from the bar code with information provided by the writer.

Martin teaches a negotiable instrument including a machine readable code, the machine readable code containing the drawer's account number, the drawee's routing number and one or more pieces of information from the group consisting of the following: a payee, the amount of negotiable instrument, a date, the identify of the drawer, a memo, and an identifier number of the negotiable instrument (col 4, lines 65+). These information are considered as personal identification information. Martin also discloses means for scanning the information on the

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negotiable instrument and means for comparing the information from the machine-readable code to the information on the negotiable instrument (col 6, lines 5-10).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Martin to the teachings of Armel because barcodes can store a lot of information with utilization of little space on the negotiable instrument, and therefore, enhances fraud protection by storing more information about the user.

8. Claim 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Armel as modified by Martin as applied to claim 1 above, and further in view of Iguchi et al (US Patent Application No. 2002/0071682). The teachings of Armel as modified by Martin have been discussed above.

Armel as modified by Martin fails to teach that the personal information from the bar code comprises a home address and telephone number.

Iguchi teaches a barcode containing customer information, such as address and telephone number (Page 8, Paragraph [0145]).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Iguchi to the teachings of Armel as modified by Martin in order to enhance fraud protection by storing more specific information regarding the user, and making it more difficult to unauthorized users to utilize the negotiable instrument.

9. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Armel as modified by Martin and Iguchi as applied to claim 3 above, and further in view of Houvener (US 5,657,389). The teachings of Armel/Martin/Iguchi have been discussed above.

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Armel/Martin/Iguchi fail to teach that the personal identification information from the bar code further comprises a digital photograph of the writer and a digital image of the writer's signature.

Houvener teaches that a database retrieval system where the database includes digital photographic image, signature or other unique data to individuals for positive identity verification purposes and a bar code system for retrieving the database information (col 4, lines 18-21 and col 5, lines 15-20).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Houvener to the teachings of Armel/Martin/Iguchi in order to enhance fraud protection by storing more specific information regarding the user, and making it more difficult to unauthorized users to utilize the negotiable instrument.

10. Claims 6-8 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsakanikas (US 5,570,465) in view of Iguchi et al.

Tsakanikas teaches a negotiable instrument including a picture of the bearer 101, the bearer's signature 103 and a bar code 107. Tsakanikas further discloses that the indicia are to enable quick identification of the bearer even prior to bar code reading or scanning of the instrument (col 16, lines 62+). Tsakanikas shows in Fig. 8 that the signature 103 is adjacent to the picture 101. The negotiable instrument does not show the pin number, social security number, driver's license number etc.

Tsakanikas fails to specifically teach that the pre-printed barcode hiding personal information about the writer.

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Iguchi teaches a barcode containing customer information, such as address and telephone number (Page 8, Paragraph [0145]).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Iguchi to the teachings of Tsakanikas in order to enhance fraud protection by storing more specific information regarding the user, and making it more difficult to unauthorized users to utilize the negotiable instrument.

11. Claims 9, 10, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsakanikas as modified by Iguchi as applied to claim 8 above, and further in view of Houvener. The teachings of Tsakanikas as modified by Iguchi have been discussed above.

Tsakanikas as modified by Iguchi fails to teach that the pre-printed bar code further comprises a digital photograph of the writer and a digital image of the writer's signature.

Houvener teaches that a database retrieval system where the database includes digital photographic image, signature or other unique data to individuals for positive identity verification purposes and a bar code system for retrieving the database information (col 4, lines 18-21 and col 5, lines 15-20).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Houvener to the teachings of Tsakanikas as modified by Iguchi in order to enhance fraud protection by storing more specific information regarding the user, and making it more difficult to unauthorized users to utilize the negotiable instrument.

12. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Steger (US 5,594,226, as cited by the Applicant) in view of Iguchi et al.

In Fig. 1A, Steger shows a negotiable instrument with no visible home address, telephone number, digital photograph of the writer, or digital image of the writer's signature. Steger shows a negotiable instrument with a barcode 12 (Fig. 1A).

Steger fails to teach a pre-printed bar code having personal information about a writer including a home address and telephone number.

Iguchi teaches a barcode containing customer information, such as address and telephone number (Page 8, Paragraph [0145]).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Iguchi to the teachings of Steger in order to enhance fraud protection by storing more specific information regarding the user, and making it more difficult to unauthorized users to utilize the negotiable instrument.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Cavanaugh, U.S. Patent No. 6,048,697, discloses method of identifying a person.

Goldwater, U.S. Patent No. 2,462,735, discloses photo identification for checks.

Leef, U.S. Patent No. 6,106,020, discloses fraud prevention method and system.

Smithson, U.S. Patent No. 4,865,351, discloses a photo check.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kumiko C. Koyama whose telephone number is 571-272-2394.

The examiner can normally be reached on Monday-Friday 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Kumiko C. Koyama
March 08, 2004



DIANE I. LEE
PRIMARY EXAMINER